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EXAMINER

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ART UNIT

PAPER NUMBER

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

Paper No. 11

Serial Number: 08/435,375  
Filing Date: 5/5/1995  
Appellant(s): Max McFarland

MAR 18 1997

Steven M. du Bois  
For Appellant

EXAMINER'S ANSWER

This is in response to appellant's brief on appeal  
filed 1/13/97.

(1) *Status of claims.*

The statement of the status of claims contained in the brief  
is correct.

(2) *Status of Amendments After Final.*

The appellant's statement of the status of amendments after  
final rejection contained in the brief is correct.

(3) *Summary of invention.*

The summary of invention contained in the brief is correct.

Art Unit: 2415

(4) *Issues.*

The appellant's statement of the issues in the brief is correct.

(5) *Grouping of claims.*

Appellant's brief includes a statement that claims 1, 2, 3, 4 and 6 do not stand or fall together and provides reasons as set forth in 37 C.F.R. § 1.192(c)(5) and (c)(6).

(6) *Claims appealed.*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(7) *Prior Art of record.*

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

US Patent #5,377,317 (Bates et al), dated 12/27/1994.

(8) *New prior art.*

No new prior art has been applied in this examiner's answer.

(9) *Grounds of rejection.*

The following ground(s) of rejection are applicable to the appealed claims.

Art Unit: 2415

Claims 1-7 are rejected under 35 USC 103. This rejection is set forth in the prior Office action paper number 2.

(10) *New ground of rejection.* This Examiner's Answer does not contain any new ground of rejection.

(11) *Response to argument.*

i. **Hindsight.** In response to Applicant's argument that the Examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgement on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. In re *McLaughlin*, 443 F.2d 1392; 170 USPQ 209 (CCPA 1971). In this instant application, the Examiner's conclusion of obviousness was based on knowledge of one of ordinary skill in the art. With his common sense, one of ordinary skill in the art would know how to keep things organized for later use by returning them to the already familiar places, where they belong. Thus, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to keep the window organized for later access

Art Unit: 2415

by returning the windows to their original locations which are already familiar to the user.

**ii. Resetting and Deactivating the timer.**

In response to the appellant's argument that resetting of the timer would result in program shut-off and the windows reordering function is no longer available to the user, the argument has been considered but is not deemed persuasive. Bates et al. teach a method for controlling display order of windows based on the amount of time the windows are in-focus. The windows that were active a longer length of time are displayed in a descending order from most to least (col. 2, lines 12-26). Thus a window will be return to its original position if the amount of active time of all windows remain the same, or the different between the amount of active time is not enough to change the display order of the windows. The amount of active time can be controlled by resetting or suspending the timer (col. 6, lines 18-35). By resetting the timer, *all windows start fresh as if they have not been activated during this section* (col. 6, lines 33-35). Therefore windows are returned to their original positions since active time of the reset-section is not counted.

In response to the appellant's argument that Bates et al. fail to teach or suggest the step of returning the window to the original position based upon a list of windows order, the

Art Unit: 2415

argument has been considered but is not deemed persuasive. Bates et al. teach the displaying of windows in a cascade order (Abstract; Col. 10, lines 11-42). Window record 40 ("list") specifies the order of the windows for the windows to be displayed in the cascade order. A windows order list 27, which provide the display order of the windows, is derived from the record 40 (col. 4, lines 29-34). When the timer is not activated, record 40 and the list 27 remain the same, and windows are returned to their original positions based upon the record 40, or indirectly based upon the list 27.

**iii. Lacks of claimed elements.**

As for claim 1, in response to the appellant's argument that Bates et al. do not teach or suggest that the record 40 includes an indicator of whether the windows is currently in its respective original cascaded position, the argument is not deemed persuasive. When the record 40 is generated at the beginning of a section, the record by itself is an indicator of whether each of the windows is currently in its original position.

As for claim 2, in response to the appellant's argument that Bates et al. fail to teach the claim element of comparing the ID of the to-be-returned window with IDs of those in the record until a match occurs, and placing the to-be-returned window behind a window which is next in order, the argument has been considered but is not deemed persuasive. Each window in

Art Unit: 2415

figure 3b includes a window identification. If a window is removed and later on returned to its original position, the system must know where to return the window to by comparing the window ID with data in a record. Window data 40 are data identifying display position of a window, thus are window identification. Therefore the step of comparing until a match occurs is implicitly included in Bates et al. The window is placed behind a window which is next in order (e.g., figure 2 shows Excel is behind Quicken).

As for claim 3, continuing from claim 2, if the windows are displayed as tiled instead of cascaded position, it would be clear as seen in figure 2b that the window will not be displayed as overlapped ("behind") by a window of next higher order. Thus the step of displaying the window behind window of next higher order only if the window is currently in its respective original cascaded position is also implicitly included in Bates et al.

As for claim 4, claim 4 recites the similar elements of claim 1 and was rejected for the similar reason as set forth in the rejection of claim 1. All possible arguments have been response to as set forth above in the response to the argument of claim 1.

As for claim 6, in response to the appellant's argument that Bates et al. fail to teach or suggest the time-invariant order as recited in the claim, the argument has been considered but is not

Serial Number: 08/435,375

-7-

Art Unit: 2415

deemed persuasive. Bates et al. teaching of resetting and suspending the timer suggests the time-invariant order recited in the claim. It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to deactivate the window timing function in Bates such that to display the window in a fixed order, which is more familiar to the user. It has been held that the elimination of an element when its function is not desired would have been obvious to one of ordinary skill in the art. In re Wilson, 153 USPQ 740 (CCPA 1967).




Serial Number: 08/435,375

-8-

Art Unit: 2415

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

  
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SUPERVISORY PATENT EXAMINER  
ART UNIT 2415

Huynh-Ba  
March 5, 1997

*HB*

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